

REMARKS

This application has been carefully reviewed in light of the Office Action dated January 8, 2007. Claims 1 to 3, 5 to 7, 9 to 15, 17 to 19 and 21 to 26 are in the application. Claims 1, 7, 13, 19, 25 and 26 are independent. Reconsideration and further examination are respectfully requested.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1 to 3, 5 to 7, 9 to 15, 17 to 19 and 21 to 26 were rejected under 35 U.S.C. § 112, first paragraph. The rejections are respectfully traversed, since (1) one skilled in the art would readily find support in the specification as filed for the features in question, and (2) point 1 has been conceded through assertions made in previous Office Actions.

More particularly, in entering the current rejections of independent Claims 1, 13 and 25 the current Office Action asserts that “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (page 2 of Office Action). Specifically, the Office Action requires “correction and/or clarification”, asserting that “[t]here does not appear [to one skilled in the art] to be any support for storing a common mark specific to a target area in the Specification. Although the specification discloses marking nodes that fit into a target area. *The marking of a node does not signify storing a node* [sic, storing data indicating a common mark with a node].” (pages 2 to 3 of Office Action)(emphasis added).

However, Applicant submits the record established by previous Office Actions is clear, since the previous Office Actions throughout prosecution have taken the position that marking signifies storing data:

Office Action dated July 14, 2005

“Thus *Kothuri’s marking of the nodes* with a unique identifier [i.e., storing the unique identifier of the corresponding node] serves the same purpose as the claimed invention’s marking of nodes to create a split tree in that it identifies the root or start of a new tree fragment.” (pages 4 to 5)(emphasis added)

“Since Kothuri teaches using an identifier for the nodes in the galley target, it would have been obvious to one skilled in the art at the time of the invention to ‘mark’ the nodes as a mark is simply a means for identification which is disclosed by Kothuri.” (page 4)

Office Action dated March 6, 2006

“It would have been obvious to a person of ordinary skill in the art at the time of the invention to recognize that in splitting a node into two nodes and marking them with [Kothuri’s] id generated by the node_id generator provides a means to mark nodes that fit into a certain target area” (page 4)(emphasis added)

“A ‘mark’ is simply a means for identification of [a node].” (page 4)

“[Kothuri’s] first object in a database . . . is configured to *store* information concerning the index . . . and an identifier . . . [such as] a unique identifier of the corresponding node . . . *These [stored] identifiers are similar to the claimed ‘marks’*” (pages 3 to 4)(emphasis added)

See also, the Office Action dated March 18, 2005 and the Office Action dated June 9, 2004, each of which contains similar assertions as the foregoing Office Actions.

Office Action dated November 10, 2003

“Hayashi teaches . . . *storing . . . layout directive information* . . . Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to mark the nodes specific to the galley target because providing layout type information indicating whether the content is laid out in certain

areas was well known in the art at the time of the invention and providing such *layout information is an indicator as is a mark.*” (pages 3 to 4)(emphasis added)

“Thus the [stored] layout directive [information] ‘marks’ the content” (pages 4 to 5)

“Hayashi teaches including layout type information . . . [t]hus they are taking into consideration its ‘mark’.” (page 5)

Against the weight of the instant record, the current Office Action’s new assertion that marking does not signify storing data is untenable.

Moreover, in light of the instant record Applicant respectfully disagrees that “correction and/or clarification is required.” On the contrary, Applicant submits the record is clear, as established by the previous Office Actions, that marking signifies storing data.¹ Nonetheless, Applicant submits one skilled in the art would readily find support throughout the specification as filed for the feature of storing data indicating a common mark specific to the target area with each node that fits into the target area. (See, e.g., page 7, lines 9 to 19; page 8, lines 14 to 17; page 10, lines 9 to 12; page 10, lines 14 to 21; page 12, lines 1 to 4; page 13, lines 20 to 23; page 13, line 24 to page 15, line 19; and Figures 7, 8, 9, 10, 11, 12 and 13, and corresponding text of the specification).

With regard to independent Claims 7, 19 and 26, the Office Action asserts that these claims “similarly recites, ‘storing the tree fragment’. There does not appear to be any support for storing a common mark specific to a target area in the Specification.” (page 3 of the Office Action). Inasmuch as Applicant understands the rejection, Applicant respectfully disagrees.

^{1/}Applicant does not concede the correctness of any other aspect of the reasoning in these previous rejections.

Applicant believes the rejection is meant to assert that the specification does not support the feature of storing the tree fragment. However, the specification clearly supports this feature. For example, in one embodiment of the present invention shown in Figure 10, a method 40 for generating tree fragments is disclosed. Method 40 calls a procedure 70 (shown in Figure 12) for generating nodes of the tree fragment. “Procedure 70 is invoked recursively to find all the nodes of a tree fragment in a split tree and to generate the whole tree fragment.” (page 12, lines 2 to 3 of the specification). In particular, procedure 70 “may include *saving the result to a file*, modifying the attributes of the nodes or displaying the result in a tree form on a user interface.” (page 12, lines 16 to 18)(emphasis added).

Accordingly, the rejections are respectfully traversed. Reconsideration and withdrawal of the rejections are respectfully requested.

Rejections under 35 U.S.C. § 101

Claims 1 to 3, 5 to 7, 9 to 15, 17 to 19 and 21 to 26 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. The rejections are respectfully traversed, since the rejections are believed to be improper. Specifically, the rejections are not based on the current claim language, rather, the rejections are directed to previous claim language which has since been removed or amended.²

In particular, the Office Action repeats rejections from the previous Office Action, which asserted that the previous claims failed to produce a tangible result because “marking nodes with a common mark specific to a target area does not necessarily produce

²Other reasons for traversal are given below for the rejections of specific claims.

a tangible result unless the structure of the input tree is either saved, stored, or displayed” (independent Claims 1, 13 and 25) or “generating the tree fragment from the nodes marked with the common mark does not produce a tangible result unless the tree fragment is saved, stored, or displayed” (independent Claims 7, 19 and 26). (page 4 of the Office Action). However, without conceding the correctness of those previous rejections, the claims were amended in the Amendment filed on October 26, 2006.

In contrast to the current rejections, amended Claims 1, 13 and 25 include features directed to “storing data indicating a common mark specific to the target area with each node that fits into the target area”, and amended Claims 7, 19 and 26 include features directed to “storing the tree fragment”. Accordingly, Applicant submits the current rejections are improper, since they clearly are not directed to the current claims, particularly in light of Office Action’s indication that “saving, storing, or displaying” produces a tangible result.

In addition, the Office Action takes the position that Claims 13 and 19 are directed to software *per se*. (pages 5 to 6 of the Office Action). Applicant respectfully disagrees, since Claims 13 and 19 are apparatus claims, which are clearly statutory.

In particular, the Office Action asserts that Claims 13 and 19 are “interpreted in [their] broadest reasonable sense as [software *per se*]”. (pages 5 and 6 of the Office Action). Since Claims 13 and 19 are directed to apparatuses, Applicant respectfully disagrees that the “broadest reasonable” interpretation is that the claims are directed to nothing more than “computer listings *per se*, i.e., the descriptions or expressions of [computer] programs, [which] are not ‘physical things.’” (MPEP § 2106.01(I)). If the Examiner is interpreting “An apparatus” in Claims 13 and 19 as nothing more than

“descriptions or expressions of [computer] programs”, Applicant respectfully requests the Examiner clarify her interpretation of “an apparatus” for the record.

In addition, the Office Action asserts that the computer-readable medium of Claims 25 and 26 could be interpreted as a carrier wave. (pages 7 and 8 of the Office Action). Amendments to Claims 25 and 26 are believed to obviate this basis for rejection.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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